GAU 1641
#13
9-15-00

DOCKET NO. 14014.0327
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
Steven et al.	)	
	)	Group Art Unit: 1641
Serial No. 08/837,301	)	
	)	Examiner: Cook, L.
Filed: April 11, 1997	)	
	)	
For: "PHAGE DISPLAY OF INTACT DOMAIN AT HIGH COPY NUMBERS"	)	

ELECTION UNDER RESTRICTION REQUIREMENT

Assistant Commissioner
for Patents
Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C
Suite 1200, The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811

August 31, 2000

Sir:

This is in response to the Office Action dated August 2, 2000, wherein restriction of the claims of the above-identified application is required.

The Examiner has restricted the invention into six groups:

Group I: Claims 57-67, drawn to a composition containing a T4 surface lattice protein.

Group II: Claims 68-78 and 96, drawn to a method of making the composition of claim 57.

Group III: Claims 79-89 and 97, drawn to a second method of making the composition of claim 57.

Group IV: Claims 90-95, drawn to methods of immunizing or treating a mammal with an antigenic composition.

Applicants provisionally elect Group I, claims 57-67, with traverse. Applicants also request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all of the claims. M.P.E.P. § 803 provides:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden.

Applicants respectfully assert that the Examiner has not shown that the second requirement has been met on the basis that the Examiner has not shown that it would be a serious burden to search and examine all of the claims together. The subject matter of the claims in Groups II, III and IV is recited in claims that depend from claim 57 in elected Group I. Therefore, if claim 57, the broadest claim, is found to be free of the prior art, any claim depending from claim 57 should also be free of the prior art. A search broad enough to identify art relevant to claim 57, will also be broad enough to identify art relevant to Groups II, III, IV. Thus, this criterion of M.P.E.P. § 803 as set forth above has not been satisfied, because the

Examiner has not shown that it would be a serious burden to search and examine all of the claims of this invention together.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the U.S. Patent and Trademark Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Thus, applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Applicants also wish to remind the Examiner of the guidelines for rejoinder of claims as set forth in M.P.E.P. § 821.04, as they apply to the pending claims of the instant application.

No additional fees are believed due, however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

Gwendolyn D. Spratt
Registration No. 36,016

Suite 1200, The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811
(404) 688-0770

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 31, 2000.

Gwendolyn D. Spratt — Date: 8-31-00